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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,898	04/30/2001	Ronald J. Kolata	102863-2	4070
21125	7590	12/29/2004	EXAMINER	
NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			RAMANA, ANURADHA	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/845,898

Applicant(s)

KOLATA ET AL.

Examiner

Anu Ramana

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 37-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-15 and 37-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

The indicated allowability of claims 7-15 is withdrawn in view of the newly discovered references. Rejections based on the newly cited reference(s) follow.

#### ***Claim Objections***

Claims 7-15 are objected to as being substantial duplicates of claims 38-46. Applicant is required to cancel or amend the claims prior to allowance of the instant application. See 37 CFR 1.75 (d).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 37-38, 40-42 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taber (US 406,546) in view of Camp (US 5,119,585).

Taber discloses an instrument having a body, a tissue grasping element appended to the body with first and second opposed tissue penetrating claws B movable between an open and closed position and actuating member D mated to the body, effective to move the tissue grasping element between open and closed positions (Figs. 1, 2, col. 1, lines 19-50 and col. 2, lines 70-100). Refer following marked up Fig. 1 from Taber.

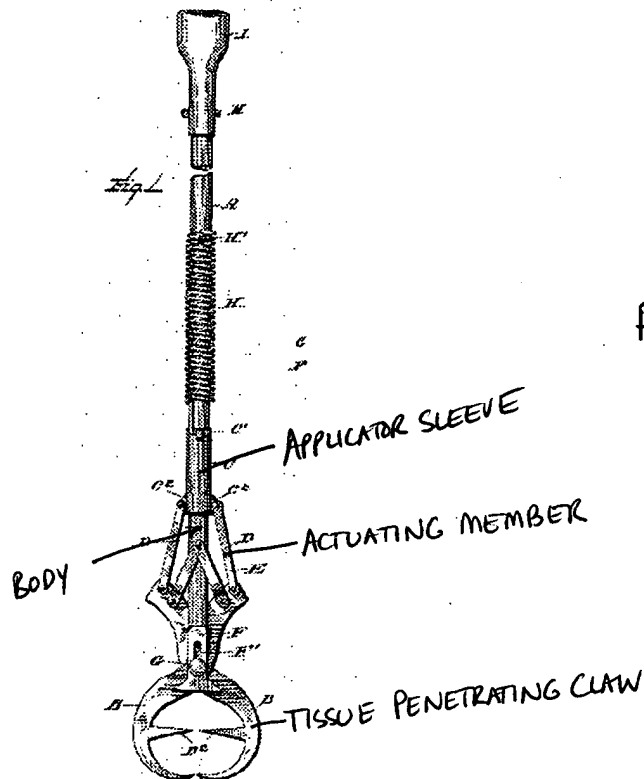


FIG 1 FROM TABER (406,546)

Taber does not disclose a flexible member secured to the instrument body.

Camp teaches a flexible member or band 94 attached to a hand tool to prevent accidental dropping of the tool when in use by allowing the tool to hang from the wrist of the user (Fig. 1 and col. 4, lines 35-42).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a flexible member, as taught by Camp, on the body of the Taber instrument to keep the tool attached to the hand of the user to prevent accidental dropping of the tool.

Regarding claims 7 and 38, Taber discloses a removable sleeve C (i.e., a sleeve capable of being removed, if one should so desire), adapted to selectively engage the actuating member D.

The method steps of claim 37 are performed during use of the device of the combination of Taber and Camp for the purpose of gripping tissue or an organ.

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Claims 1, 3-7, 37-38, 40-42 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaslavsky et al (US 6,228,023) in view of Camp (US 5,119,585).

Zaslavsky et al. disclose an instrument having a body 84, a tissue grasping element 90 appended to the body with first and second opposed tissue penetrating claws 92, 94 movable between an open and closed position and an actuating member 96, 86 mated to the body, effective to move the tissue grasping element between open and closed positions (Fig. 3, col. 7, lines 4-67 and col. 8, lines 1-44).

Zaslavsky et al. do not disclose a flexible member secured to body 84.

Camp teaches a flexible member or band 94 attached to a hand tool to prevent accidental dropping of the tool when in use by allowing the tool to hang from the wrist of the user (Fig. 1 and col. 4, lines 35-42).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a flexible member, as taught by Camp, on body 84 of Zaslavsky et al. to keep body 84 attached to the wrist of a user to prevent accidental dropping of body 84.

Regarding claims 7 and 38, Zaslavsky et al. disclose a removable applicator sleeve 82.

The method steps of claim 37 are performed during normal operation of the device of the combination of Zaslavsky et al. and Camp for the purpose of gripping tissue or an organ.

Claims 1, 3-15 and 37-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shang (US 5,826,928) in view of Camp (US 5,119,585).

Shang discloses an instrument having a body (17,19, 20), a tissue grasping element appended to the body with first and second opposed tissue penetrating claws 13 movable between an open and closed position and an actuating member (11,14) mated to the body, effective to move the tissue grasping element between open and closed positions (Figs. 1-3, col. 1, lines 46-47 and col. 2, lines 1-31).

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Shang does not disclose a flexible member secured to the instrument body.

Camp teaches a flexible member or band 94 attached to a hand tool to prevent accidental dropping of the tool when in use by allowing the tool to hang from the wrist of the user (Fig. 1 and col. 4, lines 35-42).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a flexible member, as taught by Camp, on body of Shang to keep the Shang instrument attached to the wrist of a user to prevent accidental dropping of the instrument.

Regarding claim 5, Shang discloses the claimed invention except for the tissue-grasping element forming a substantially circular shape in a closed position. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to have provided tissue grasping elements in the device of the combination of Shang and Camp having a substantially circular shape in a closed position, since applicant has not disclosed that such a shape solves any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a tissue grasping member. In re Dailey and Eilers, 149 USPQ 47 (1966).

Regarding claim 8, Shang discloses an applicator sleeve 16 movable between a proximal position in which the sleeve is free from contact with actuating member 11 and a second distal position in which the sleeve engages the actuating member thereby moving the tissue grasping elements 13 between open and closed positions.

The method steps of claim 37 are performed during normal operation of the device of the combination of Shang and Camp for the purpose of gripping an object such as an organ.

### ***Response to Arguments***

Applicants' arguments with respect to claims 1, 3-6 and 37 submitted under "REMARKS" in the response filed on October 1, 2004 have been considered by the Examiner but are not persuasive for the following reasons.

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In response to Applicant's argument that Taber and Camp are in nonanalogous art, it has been held that a prior art reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Taber and Camp are both directed to hand-held gripping tools, clearly related to Applicant's invention of a hand-held gripping tool, regardless of its intended use, namely heart surgery.

In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) And *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Camp clearly teaches a flexible member for securing a tool to a support, herein a hand.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Amrullah Ramana*  
December 22, 2004

*Cary E. O'Connor*  
Cary E. O'Connor  
Primary Examiner